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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/817,060

04/02/2004

Richard J. Schneider

AC038 (26668-113)

2661

73824 7590 04/28/2009
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EXAMINER

PANDYA, SUNIT

ART UNIT

PAPER NUMBER

3714

NOTIFICATION DATE

DELIVERY MODE

04/28/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USpatents@armstrongteasdale.com

Office Action Summary	Application No. 10/817,060	Applicant(s) SCHNEIDER, RICHARD J.	
	Examiner SUNIT PANDYA	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/16/09 has been entered.

Response to Amendment

This action is in response to amendments filed 1/16/09, wherein the examiner acknowledges that claims 1, 7, 16 & 21 are currently amended, no claims have been added or canceled by the applicant. Consequently, claims 1-21 are currently pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 1-6, 16-20 are rejected under 35 USC 101 as being directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (quoting *Benson*, 409 U.S. at 70); *Parker v.*

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Flook, 437 U.S. 584, 588 n.9 (1978) (citing Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)). See also In re Bilski (Fed Cir, 2007-1130, 10/30/2008) where the Fed. Cir. held that method claims must pass the "machine-or-transformation test" in order to be eligible for patent protection under 35 USC 101.

In cited claims above, the subject matter in the claims is not functionally tied to gaming machine, and thus fails the "machine-or-transformation" test.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher (US Patent Publication 2003/0060266), and further in view of Rowe (US Patent 6,620,046).

Claims 1, 7: Baerlocher teaches of a method for initiating access to a secondary game on a gaming device during the play of the primary game, comprising accepting a wager, comparing the wager to a pre-selected wager threshold (or monetary input trigger condition) and initiating the secondary (bonus) game when the accepted wager equals the pre-selected wager threshold, wherein the initialization of the bonus game occurs when the wagered amount crosses a threshold (or a monetary input trigger condition) (0061-0062 & 0065). Baerlocher also discloses of reporting or awarding the

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outcome as a result of the wagering game (0020, 0067). Baerlocher teaches of bonus condition being activated when the monetary input surpasses predefined amount and when the base game has achieved a bonus trigger condition, thus Baerlocher fails to teach that the bonus game is independent from the output of the base game.

However in a related art, Rowe who teaches of a method for awarding bonuses in a gaming environment, allows implementing a bonus game which is independent of specific outcome of a base game played on a gaming machine. Thus, according to Rowe, a player does not have to achieve a predefined condition or a trigger condition in a base game to activate a bonus game (col. 12: 56-67). Thus it would have been obvious for one with ordinary skill in the art at the time of the invention, to have implemented an independent bonus game as taught by Rowe in the gaming system taught by Baerlocher, thus increasing player's desire to continue playing because they know that they can be eligible for a bonus regardless of their performance on the base game (col. 12: 62-67).

Claim 2: Baerlocher teaches of accepting a wager to play the base (primary) game (0032).

Claims 3, 20: Baerlocher teaches initiating the secondary (bonus) game when the accepted wager equals the pre-selected wager threshold (0061-0062 & 0064).

Claim 4: Baerlocher teaches comparing the accepted wager to a maximum wager (0073).

Claim 5: Baerlocher teaches comparing the accepted wager to an amount less than a maximum wager (0067-0068).

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Claim 6: Baerlocher teaches of a gaming machine with a secondary game comprising accepting a wager, comparing the wager to a pre-selected wager threshold and initiating the secondary (bonus) game when the accepted wager equals the pre-selected wager threshold, wherein the initialization of the bonus game occurs when the wagered amount crosses a threshold (or a monetary input trigger condition) (0061-0062 & 0065), however Baerlocher fails to teach a player tracking card, used by the player during the game play.

Rowe teaches of player tracking card, which is inserted into the gaming machine, wherein the gaming machine, includes a play counter, which tracks the amount of money paid into the slot machine by the player (col. 7: 58-67). It would have been obvious for one with ordinary skill in the art at the time of the invention to have modified Baerlocher to include a player tracking card as taught by Rowe, which tracks the amount of money paid into the gaming machine by the players, to track the amount played by the player (col. 8: 32-36)

Claim 8: Baerlocher teaches of a first indicator for primary game and a second indicator for a secondary game (0035-0037).

Claim 9: Baerlocher teaches of reel being an indicator (0032).

Claim 10: Baerlocher teaches of wheel being a second indicator (0032).

Claims 11, 13: Baerlocher teaches the prestored trigger being a wager type or amount (0061-0062).

Claim 12: Baerlocher teaches that the wager type is a maximum wager amount (0073).

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Claim 14: Baerlocher teaches that the prestored trigger is a wager source (wherein the wager source is the source which evokes machine into action 0061-0062).

Claim 15: Rowe teaches that the wager source is a player-tracking card (col. 8: 20-32).

Claims 16, 21: Baerlocher teaches of a gaming machine with a secondary game comprising accepting a wager on primary or base game, comparing the wager to a pre-selected wager threshold (or a monetary input trigger condition) and initiating the secondary (bonus) game when the accepted wager equals the pre-selected wager threshold (or a monetary trigger condition) (0061-0062 & 0064) wherein the initialization of the bonus game occurs when the wagered amount crosses a threshold (or a monetary input trigger condition) (0061-0062 & 0065). Baerlocher also discloses of reporting or awarding the outcome as a result of the wagering game (0020, 0067). Baerlocher teaches of bonus condition being activated when the monetary input surpasses predefined amount and when the base game has achieved a bonus trigger condition, thus Baerlocher fails to teach that the bonus game is independent from the output of the base game.

However in a related art, Rowe who teaches of a method for awarding bonuses in a gaming environment, allows implementing a bonus game which is independent of specific outcome of a base game played on a gaming machine. Thus according to Rowe, a player does not have to achieve a predefined condition or a trigger condition in a base game to activate a bonus game (col. 12: 56-67). Thus it would have been obvious for one with ordinary skill in the art at the time of the invention, to have

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implemented an independent bonus game as taught by Rowe in the gaming system taught by Baerlocher, thus increasing player's desire to continue playing because they know that they can be eligible for a bonus regardless of their performance on the base game (col. 12: 62-67, thus the combination of Baerlocher and Rowe will allow for the activation of secondary game regardless of timing of comparison, since the base game is not associated with activation of bonus game).

Claims 17-19: Baerlocher teaches that the first outcome is the primary game outcome and secondary outcome is the secondary or bonus game outcome, and any combination thereof with the primary and the secondary game outcomes (0036-0044 & 000061-0065).

Response to Arguments

Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

The examiner would also like to point out that, in the rejection above, the examiner has cited particular columns and line numbers or paragraph numbers from the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part

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of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUNIT PANDYA whose telephone number is (571)272-2823. The examiner can normally be reached on M-Th 8 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/
Supervisory Patent Examiner, Art Unit 3714

SP